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In re Application of :
TRAN *et al* :
U.S. Application No.: 10/535,635 :
PCT No.: PCT/US2003/038178 :
Int. Filing Date: 25 November 2003 :
Priority Date: 26 November 2002 :
Attorney Docket No.: 039386-2269 :
For: IMMUNE RESPONSE-ASSOCIATED :
PROTEINS :

DECISION

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.47(a) - Nainder K. Chawla" filed 02 March 2006.

BACKGROUND

On 05 December 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 02 March 2006, applicants filed the instant petition which was accompanied by, *inter alia*, the petition fee; a one-month extension and fee; the surcharge fee; a declaration; copies of two letters; and copies of FedEx postal delivery results.

DISCUSSION

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor.

Concerning item (1), the \$200.00 petition fee has been paid.

With regards to item (3), the last known address of Narinder K. Chawla-Walis is listed as:

33 Union Square # 417
Union City, CA 94587

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration signed by fourteen of the fifteen named inventors on their own behalf and on behalf of the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

Items (1), (3) and (4) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), the 37 CFR 1.47(a) applicant claims that the nonsigning inventor "is refusing to join in the subject application by executing the Declaration. Further, Ms. Chawla-Walia is now unable to be located." These allegations will be discussed, in turn.

Section 409.03(d) of the MPEP discusses a refusal by an inventor to cooperate and states, in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted.

Petitioners claim that Christine Arthur, a legal assistant of counsel, talked to the nonsigning inventor on 07 September 2005 about the documents mailed 31 May 2005.

Ms. Chawla-Walia told Ms. Arthur that she needed another copy of the documents as the documents mailed 31 May 2005 were misplaced during a move. A duplicate set of documents were sent that day. But FedEx delivery records show that these documents were delivered to an address other than the recipient.

Ms. Arthur called the nonsigning inventor again on 14 November 2005 and was told that the documents were never received. Petitioners sent more documents to the new address on 16 November 2005 and delivery records indicate that they were delivered. Ms. Chawla-Walia did not respond to the deadline of 01 December 2005 and subsequent telephone calls by Ms. Arthur indicate that the phone has been disconnected.

A review of the letter dated 16 November 2005 shows that only a Declaration and Assignment were included. There is no indication that a copy of the subject application was included. While the cover letter dated 31 May 2005 did state that a copy of the international application was included, the facts as described in the petition suggest that the nonsigning inventor had misplaced these papers. Moreover, the statements in the petition are complete hearsay. An affidavit by the person with direct knowledge of the conversations (Ms. Arthur) is required. For these two reasons, a refusal to cooperate has not been shown.

Section 409.03(d) of the MPEP also discusses situations where an inventor cannot be reached and states, in part:

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioners have not made a showing that a diligent effort was made to locate the nonsigning inventor. There is no indication that any search was performed. No documentary evidence of searches was submitted. Moreover, a statement of facts by the person having firsthand knowledge of the facts (Ms. Arthur) is also required. For these reasons, petitioners have not made an acceptable showing of diligent effort to locate the nonsigning inventor.

For the reasons discussed above, item (2) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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